

R E M A R K S

I. Introduction

In response to the pending Office Action, Applicants have amended claims 18-22, 24 and 25 to more specifically recited the intended subject matter of the present invention, and have added new claims 26 and 27, which are directed to additional aspects of the present invention not previously claimed. No new matter has been added.

For the reasons set forth below, it is respectfully submitted that all pending claims are patentable over the cited prior art references.

II. The Rejection Of Claims 24 And 25 Under 35 U.S.C. § 102

Claims 24 and 25 were rejected under 35 U.S.C. § 102 as being anticipated by USP No. 5,600,706 to Dunn. Applicants respectfully submit that for the reasons set forth below claims 24 and 25, as amended, are patentable over Dunn.

As recited by claim 24, the present invention relates to mobile station for communicating with a cellular network comprising a controlling base station and a plurality of positioning elements. The mobile station operates to receive positioning signals from the plurality of positioning elements. ***Importantly, the base station transmits a signal to the mobile station which informs the mobile station of the expected time of arrival and the character of the positioning signals prior to the transmission of the positioning signals by the positioning elements.***

Turning to the cited prior art, it is clear that, at a minimum, Dunn fails to disclose the foregoing limitation recited by claim 24. While not expressly stated, it is presumed

that the range transceivers 30 of Dunn are asserted as corresponding to the recited positioning elements of the present invention. As stated in Dunn, during operation:

[e]ach of the range transceivers is adapted to ***periodically*** transmit approximately synchronized digital range signals (see, col. 6, lines 9-12).

Thus, the range signals in Dunn are periodically transmitted by the transceivers, which means the signals are transmitted at some predetermined rate, and the mobile unit periodically monitors the secondary channel in order to receive the digital range signals. As such, there is no need in the device of Dunn for a base station to ***transmit a signal to the mobile station which informs the mobile station of the expected time of arrival and the character of the positioning signals prior to the transmission of the positioning signals by the positioning elements***. Indeed, the device of Dunn does not perform this operation. In fact, it does not appear that Dunn has any device that can be considered comparable to the claimed base station. In this regard it is noted that the primary receivers 38 of Dunn merely communicate with the range transceivers 30 and function to synchronize the timing of the range signals transmitted by the range receivers 30. However, the primary receivers 38 of Dunn do not appear to even communicate with the mobile units. As such, it is clear that the primary receivers 38 cannot be properly considered to correspond to the claimed base station. Thus, at a minimum, Dunn fails to disclose the foregoing limitation.

Furthermore, as a result of the claimed technique, the positioning elements of the present invention have a direct and known timing relationship to the base station transmissions. This information coupled with their known location advantageously eliminates the need for any additional monitoring of the positioning elements' signals or the base station's signals when determining position of mobile unit. In contrast, in

Dunn's device, without such additional monitoring and/or reporting infrastructure over and beyond the range transceivers 30, positioning information of the mobile unit cannot be calculated. Thus, it is clear that Dunn does not disclose the present invention.

Accordingly, as anticipation under 35 U.S.C. § 102 requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference, *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983), for the foregoing reasons, it is clear that Dunn does not anticipate amended claim 24, or any claim dependent thereon.

III. The Rejection Of The Claims Under 35 U.S.C. § 103

Claims 18-23 were rejected under 35 U.S.C. § 103 as being obvious over USP No. 5,600,706 to Dunn in view of USP No. 5,765,112 to Fitzgerald. Applicants respectfully submit that for the reasons set forth below claims 18-23, as amended, are patentable over Dunn and Fitzgerald taken alone or in combination with one another.

In the pending rejection it is asserted that Dunn discloses a base station which functions to transmit a signal to the mobile station, which identifies the window of detection of positioning signals, and which receives a report from the mobile station regarding the results of the detection. Applicants respectfully traverse this conclusion. First, it is noted that in the pending rejection it appears that the range receivers 30 of Dunn are asserted as corresponding to the claimed base station. However, as noted above, the range receivers 30 do not transmit a signal which informs the mobile unit of the time of arrival of the positioning signal. Dunn merely discloses that the signals are transmitted periodically from the range receivers 30. Second it is also clear that the

range receivers of Dunn do not receive any report from the mobile unit. Thus, the range receivers of Dunn cannot be properly deemed to correspond to the claimed base station. Further, as stated above, it does not appear that Dunn has any device that corresponds to the claimed base station.

Turning to Fitzgerald, it is asserted that this reference discloses a base station which pages the positioning elements within the cell to transmit positioning signals. It is respectfully submitted that this conclusion is also in error. Fitzgerald discloses a system comprising a message operations center (MOC), which upon receiving a request for communication with a given field unit, functions to generate an outbound message which provides the frequency and time which the desired field unit should provide its location to a base station. However, the field unit obtains its position data from "its associated geolocation receiver or by reading other data available to it." (see, col. 3, lines 63-66). Thus, contrary to the conclusion set forth in the pending rejection, there are no paging elements disclosed by Fitzgerald, which function to generate positioning signals which are transmitted to the mobile unit. As is clear from the foregoing, upon receiving the request, the mobile unit functions to retrieve its location data from an available source. Accordingly, Fitzgerald does not cure the defects of Dunn.

As each and every element recited by the rejected claim must be disclosed or suggested by the cited prior art (see, M.P.E.P. § 2143.03) in order to establish a *prima facie* case of obviousness, and it is clear from the foregoing that the combination of Dunn and Fitzgerald fails to do so, it is respectfully submitted that the pending claims are patentable over the cited prior art.

IV. All Dependent Claims Are Allowable Because The Independent Claim From Which They Depend Is Allowable

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987).

Accordingly, as each independent claim is patentable for the reasons set forth above, it is respectfully submitted that all dependent claims are also in condition for allowance.

V. Request For Notice Of Allowance

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

Respectfully submitted,

McDERMOTT, WILL & EMERY

Date: 01.26.04

By:


Michael E. Fogarty
Registration No. 36,139

600 13th Street, N.W. , Suite 1200
Washington, D.C. 20005-3096
Telephone: 202-756-8000
Facsimile: 202-756-8087

WDC99 870556-1.063186.0014